



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,444	01/31/2005	Jean Guy G. Gilles	50304/059001	4465
21559	7590	09/04/2007		
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			EXAMINER SZPERKA, MICHAEL EDWARD	
			ART UNIT 1644	PAPER NUMBER
			MAIL DATE 09/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,444

Applicant(s)

GILLES ET AL.

Examiner

Michael Szperka

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 17-22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/31/05, 9/18/06, 10/27/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's response received June 28, 2007 is acknowledged.

Claims 2-16 have been canceled.

Claims 1 and 17-31 are pending in the instant application.

Applicant's election without traverse of Group I, claims 1, 17-22 and 24-26, drawn to anti-idiotypic antibodies in the reply filed on June 28, 2007 is acknowledged. It is noted that the restriction requirement mailed May 24, 2007 contains a typographical error in which claim 27 was erroneously placed in Group I. Claim 27 recites pharmaceutical compositions comprising peptides, and as such is properly grouped with the subject matter of Group II, namely peptides. In the interest of compact prosecution, claim 27 has been placed in its proper Group and has been withdrawn from further consideration. Applicant's request for rejoinder of the methods of Group III in the event that the subject matter of Group I is found to be allowable is noted.

Claims 23 and 27-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 28, 2007.

Claims 1, 17-22, and 24-26 are under examination as they read on anti-idiotypic antibodies, compositions comprising said antibodies, and cells that make said antibodies.

Information Disclosure Statement

2. Applicant's IDS forms received 1/31/05, 9/18/06, and 10/27/06 are acknowledged and have been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 17, 20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 17 recite "said antibody", namely in lines 4 and 6 of claims 1 and 17. These claims recite two distinct antibodies, namely an anti-idiotypic antibody and an inhibitory antibody (which is the antigen bound by the anti-idiotypic antibody). As such, which antibody is "said antibody"?

Similarly, dependent claim 20 recites numerous antibody fragments and then recites "a modified version of said fragment". Given that the claim recites more than one antibody fragment, which fragment has been altered to generate a modified version?

Claim 22 is indefinite in the recitation of "14C12" as the sole means of identifying the claimed anti-idiotypic antibody since "14C12" is merely laboratory designations that does not clearly define a particular antibody in that artisans could use the same designations to define completely distinct biological materials, or in the alternative, could use different designations to define the exact same antibody.

One possible means of obviating this ground of rejection for claim 22 is to claim the antibody by the light and heavy chain polypeptide sequences which comprise the antibody or applicant could recite an accession number for a deposit of a cell line that makes the claimed antibody as long as such a deposit satisfies the requirements of 37 CFR 1.801-1.809.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 17-22, 24, and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for antibodies, cell lines secreting antibodies and compositions comprising antibodies wherein the antibody comprises all six CDR sequences disclosed as SEQ ID NOs:5-10 in their proper spatial relationship or wherein the antibody comprises the polypeptides encoded by SEQ ID NOs:1 and 3, does not reasonably provide enablement for antibodies comprising only one recited CDR sequence or random mutations to arrive a recited percent identity. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants have claimed a genus of antibodies that bind inhibitory antibodies, wherein said inhibitory antibodies bind the C2 domain of FVIII. Inhibitory antibodies that bind FVIII inhibit the ability of FVIII to partake in the coagulation cascade, and as such patients comprising such inhibitory antibodies are prone to excessive bleeding. The specification discloses that BO2C11 is an inhibitory antibody obtained from a hemophilia patient that was used as an antigen to generate an anti-idiotypic response, with the hope that the elicited anti-idiotypic antibodies can be used in therapeutic methods. The idotype of an antibody is the unique structure formed in an antibody that provides antigen specificity (i.e. CDR loops and nearby framework residues), and it has been observed in the art that antibodies which bind antibody idiotypes often resemble the initial target antigen (i.e. antibody A binds antigen X; anti-idiotypic antibody that binds A comprises an idotype that structurally mimics the three-dimensional surface of X). Applicants have generated an anti-idiotypic antibody that binds BO2C11 that they have named 14C12, and have indicated that the idotype of 14C12 mimics FVIII and thus competes with FVIII for binding to inhibitory antibodies. As such, applicants assert that 14C12 can be administered in such a manner such that complexes preferentially form between inhibitor and 14C12, leaving FVIII unbound by inhibitor and thus able to participate in thrombus formation. 14C12 comprises the VH and VL sequences of SEQ ID NOs:2 and 4, which in turn comprise the CDR sequences of SEQ ID NOs:5-10.

Art Unit: 1644

Therefore it appears that the instant specification discloses a single member of the claimed genus of antibodies, compositions comprising such antibodies, and the cells that make such antibodies. Note that SEQ ID NO:1 encodes SEQ ID NO:2 and that SEQ ID NO:3 encodes SEQ ID NO:4.

It is well established in the art that the formation of an intact antigen-binding site requires the association of the complete heavy and light chain variable regions of a given antibody, each of which consists of three different complementarity determining regions, CDR1, 2 and 3, which provide the majority of the contact residues for the binding of the antibody to its target epitope. The amino acid sequences and conformations of each of the heavy and light chain CDRs are critical in maintaining the antigen binding specificity and affinity which is characteristic of the parent immunoglobulin (Janeway et al., Immunobiology, third edition, 1997, pages 3:7-3:11, see entire selection). It is also known that single amino acid changes in a CDR can abrogate the antigen binding function of an antibody (Rudikoff et al. PNAS USA, 1982, 79:1979-1983, see entire document, particularly the abstract and the middle of the left column of page 1982).

The instant claims recite antibodies comprising sequences at encoded by a polynucleotide at least 95% or 70% identical to either SEQ ID NO:1 or SEQ ID NO:3, as well as antibodies that comprise one or more CDRs that are 95% or 70% identical to SEQ ID NOs:5-10. Note that the claims reciting CDR sequences do not require all of the recited CDRs to be present in the claimed antibody, nor do they recite where the sequences are located in the antibody. For example, the specification discloses that SEQ ID NO:8 is CDR1 of the heavy chain of 14C12, yet the claims encompass antibodies wherein a sequence of given percent identity to SEQ ID NO:8 is in a different CDR, say CDR3. The claims do not recite, and the specification does not appear to provide guidance, as to which portions of any of the sequences recited by SEQ ID number can be changed and still maintain the capability of binding a human FVIII inhibitory antibody. Note that sequences 95% or 70% identical to SEQ ID NOs:1 or 3 can comprise mutations in the CDR sequences, and the claims reciting CDR sequences explicitly claim antibodies which comprise mutations in the CDR regions. Further,

claims 17 and 18 recite that the SEQ ID limitations are applicable to only one chain of the mature antibody such that the sequence of the other chain is not described and thus can literally be anything. Similarly, the antibodies claimed in claim 17 need only comprise a sequence 95% identical to only one of the six CDRs of 14C12, with the other CDRs again being essentially random sequence. Mele et al. disclose an antibody that comprises a sequence 100% identical to SEQ ID NO:9, yet the antibody of Mele et al. binds an antigen unrelated to FVIII inhibitors (of record, see particularly the sequence alignment provided with the restriction requirement mailed May 24, 2007). As such, more structure than what is recited in the instant claims is clearly required to ensure binding to FVIII inhibitory antibodies. Additionally, the specification does not appear to provide guidance as to how much, if any, sequence identity or functional similarity is required of antibodies that are "derived from" 14C12 as is recited in claim 22.

Given the teachings of Janeway et al. that 6 CDR of known binding specificity are required for specific antigen binding and the apparent lack of guidance, direction, or working examples in the specification concerning the pairing and structural location within an antibody molecule of sequences comprising the recited SEQ ID numbers with unknown sequences to generate antibodies comprising the recited functional properties, it does not appear reasonable that antibodies which do not minimally comprise the six CDRs of 14C12, namely SEQ ID NOs:5-10 in their correct spatial relationships would retain the recited functional properties of binding human inhibitory antibodies. Note that SEQ ID NOs:2 and 4 are the complete light and heavy chain variable domains of antibody 14C12 and therefor an antibody comprising both of these sequences would comprise sufficient structure to ensure maintenance of the recited functional properties.

Therefore, based upon the breadth of claimed invention, the lack of clear guidance or working examples as to what changes can or cannot be made to sequences recited by SEQ ID number such that sequences are 70% or 95% identical to said sequences and yet comprise an antibody that retains the recited functional properties, especially given that the claims do not recite where in an antibody these sequences are structurally located, and the art teachings that even a single amino acid

Art Unit: 1644

change in an antibody can eliminate specific binding to a target antigen, a skilled artisan would be unable to make and use the full scope of applicant's claimed products without conducting undue experimentation.

7. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim recites the cell line 14C12 deposited as accession number LMBP 5878CB and as such the cell line is a required element needed to make and use the claimed invention. As a required element, the cell line must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If it is not so obtainable or available, the enablement requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit of the pertinent cell line. See 37 CFR 1.801-1.809.

The instant specification does not appear to disclose that cell line LMBP 5878CB has been deposited under the Budapest Treaty or provide assurances that the recited material will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, and that said material will be replaced if the material becomes unviable.

If the deposit has been made under the terms of the Budapest Treaty, an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that cell line LMBP 5878CB has been deposited under the Budapest Treaty and that cell line LMBP 5878CB will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. See 37 CFR 1.808. Further, the record must be clear that the deposit will be maintained in a public depository for a period of 30 years after the date of deposit or 5 years after the last request for a sample or for the

enforceable life of the patent, whichever is longer. See 37 CFR 1.806 and MPEP 2410-2410.01. If the deposit has not been made under the Budapest treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature must be made, stating that the deposit has been made at an acceptable depository and that the criteria set forth in 37 CFR 1.801-1.809, have been met.

If the deposit was made after the effective filing date of the application for a patent in the United States, a verified statement is required from a person in a position to corroborate that the vector described in the specification as filed are the same as that deposited in the depository. Corroboration may take the form of a showing of a chain of custody from applicant to the depository coupled with corroboration that the deposit is identical to the biological material described in the specification and in the applicant's possession at the time the application was filed.

8. Claims 1, 17-22, 24, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant has broadly claimed a genus of anti-idiotypic antibodies identifiable by their percent identity to either the entirety of the antibody VH or VL domains of antibody 14C12 or by their percent identity to a subsequence of the VH and VL domains, namely the CDRs of 14C12. To support this genus, applicant has disclosed antibody 14C12 which is deposited as LMBP 5878CB. The specification does not appear to disclose what structure within 14C12 is responsible for binding human factor FVIII inhibitory antibodies other than that the CDRs of 14C12 mediate antigen binding. As such, it is not clear what changes can be made to the CDRs of 14C12 such that they maintain a structure that allows for continued antigen binding. Note that the claims explicitly recite antibodies comprising sequence, and therefore structural, alterations, from the sequences disclosed for 14C12. Such claims comprise differences due requirements

Art Unit: 1644

that the claimed antibodies only comprise one of the recited list of CDRs, as well as the recitation of less than 100% identity for the structural elements that are positively recited.

The guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, § 1 "Written Description" Requirement make clear that if a claimed genus does not show actual reduction to practice for a representative number of species, then the Requirement may be alternatively met by reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Fri. January 5, 2001, see especially page 1106 column 3).

In University of California v. Eli Lilly and Co. (CAFC) 43 USPQ2d 1398, the court noted: "A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene (in the instant case, a peptide) does, rather than what it is. See Fiers, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing Amgen). It is only a definition of a useful result rather than a definition of what achieves that result. Many such genes (peptides) may achieve that result. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See In re Wilder, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material."

The court has also noted that "Adequate written description requires a precise definition, such as by structure, formula, chemical name or physical properties, not a mere wish or plan for obtaining the claimed chemical invention." Id. at 1566, 43 USPQ2d at 1404 (quoting Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606). Also see

Enzo-Biochem v. Gen-Probe 01-1230 (CAFC 2002).

As discussed above, it does not appear that the recited structural features are sufficient to provide a precise definition of an antibody molecule that comprises the recited functional properties, and the disclosure of the single member of the genus, namely 14C12, is not representative of the claimed genus because the important structural elements of 14C12 are not necessarily present in the claimed genus of antibodies.

Therefore, it appears that the broad genus of antibodies claimed by applicants lacks adequate written description because the recited structural requirements, in the instant case amino acids sequences, are not representative of the overall structure of the claimed antibody molecule, nor are the recited structural requirements clearly correlated with the recited functional properties. As such a skilled artisan would reasonably conclude that applicants were not in possession of the claimed genus of antibodies at the time the application was filed. If applicants were not in possession of the claimed genus of antibodies, then it follows that applicants were not in possession of cells that secrete the genus of antibodies nor were they in possession of pharmaceutical compositions comprising said genus of antibodies.

9. No claims are allowable.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Szperka whose telephone number is 571-272-2934. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Michael Szperka", with a long horizontal flourish extending to the right.

Michael Szperka, Ph.D.
Patent Examiner
Technology Center 1600
August 29, 2007